

REMARKS

Introduction

This Amendment and Reply addresses issues raised in the Office Action dated March 3, 2009. Prior to the entry of the present Reply and Amendment Claims 2 – 6 were pending in the application while claim 1 stood cancelled. With the present Reply and Amendment, Applicants cancel claims 2-5 and present the claimed subject matter of claims 2-5 within new claims 7-10, respectively, for purposes of clarity and consistency.

Applicants timely file herewith: (1) a Request for Continued Examination with the fee set forth in 37 CFR 1.17(e); and (2) a Supplemental Information Disclosure Statement. New arguments in support of patentability are presented herein. Claims 6-10 are presented for continued examination.

Information Disclosure Statement

The Examiner notes that the references disclosed in the International Search Report issued January 22, 2004 in the parent PCT application (PCT/EP03/06273) were not previously provided with the Information Disclosure Statement filed December 14, 2004. The Examiner further notes that the EP 0270260 reference cited in the International Search Report is not related to the present invention and should be deleted despite the reference having been cited as an "X" category document. In reply, Applicants submit contemporaneously herewith a Supplemental Information Disclosure Statement reciting the references cited in the search report of January 22, 2004 with the exception of the EP 0270260 reference. Applicants also provide a copy of each reference.

Rejection of claims 3-6 (now claims 6 and 8-10) under §103(a)

Claims 3-6 are rejected under 35 U.S.C §103(a) as being unpatentable over WO01/54501 (Ruegg). The Examiner contends that Ruegg generically teaches compounds and herbicidal compositions that comprise a compound of formula (I) and a synergistically effective amount of one or more compounds of formula 2.1 to 2.51. The Examiner further contends that the instantly claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare compounds embraced by the disclosed genus. Finally, the Examiner notes that no unexpected or obvious results were noted for the compounds substituted as the two position. Applicants respectfully traverse.

Ruegg does not provide any suggestion or motivation to one skilled in the art to make the modifications necessary to arrive at the claimed compound. The Federal Circuit has held that the generic disclosure of an invention may not invalidate or render a species unpatentable. See In re Baird, 16 F.3d 380 (Fed. Cir. 1984). In the instant case, the claims are directed a specific (non-obvious) selection of alternative herbicidally active nicotinoyl derivatives. While an overlap exists with regard to the (extremely broad) generic scope afforded by Ruegg, Applicants note that Ruegg does not teach or fairly suggest the selection of compounds having a formula IA as instantly claimed. Specifically, with regard to the instant compounds of Formula IA, the L-W group is located in the 2-position of the pyridine ring. In contrast, the substantial generic teaching of Ruegg simply suggests, for example, that the pyridine ring may be substituted (in an undefined position) with a monocyclic or fused bicyclic ring which may contain from 1 to 4 heteroatoms wherein the ring can be attached to pyridine via, for example, a C₁-C₄ alkylene group. In the specific examples, Ruegg discloses the ring is S-linked to the pyridine in the 2-position (e.g., S-Ph, SOPh and SO₂Ph for example as disclosed in respect of compounds 1.013, 1.014 and 1.015 on page 45). Ruegg does not, however, provide any specific examples of molecules comprising an L-W group in the 2-position as taught by the present invention. Accordingly, Applicants submit that the substantial generic teaching of Ruegg does not actually provide any motivation to the skilled person to derive the select compounds of Formula IA. As such, the subject matter of the amended claims is non-obvious vis-à-vis Ruegg for this reason alone.

Secondly, Applicants note that Ruegg relates to mixtures of a herbicidally effective amount of a compound of Formula (I) with a synergistically effective amount of one or more compounds of formula 2.1. Ruegg only discloses biological data for compounds of Formula 1.001 and E8. As noted above, the specific compounds disclosed by Ruegg (including 1.001 an E8) are completely unrelated to those instantly claimed insofar as the compounds of Ruegg do not comprise an L-W group in the two position. The biological data presented in Ruegg would suggest, for example, that the claimed compounds, as exemplified by 1.001, provide no pre-emergence action alone toward the test species "Cyperus" (see Table B19-B21) and, in order to start achieving control, a mixing partner is required. In view of the test data provided in Example B1 (page 137) of the instant application, one of ordinary skill will appreciate that the vast majority of the compounds tested exhibit activity towards Cyperus. Accordingly, an unexpected and unobvious result is exhibited. Thus, the Applicants request withdrawal of this rejection under §103(a) for this additional reason.

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In view of the foregoing arguments, no prima facie case of obviousness has been made out by the Examiner. With the explanations presented herein, the Examiner is respectfully requested to withdraw the §103 rejection of the claims.

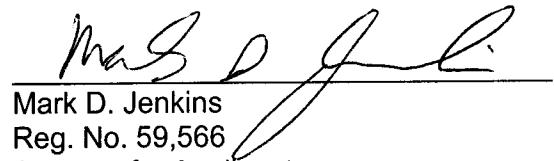
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CONCLUSION

Present claims 6-10 are allowable over the cited art. Withdrawal of all rejections is respectfully requested, along with issuance of a Notice of Allowance. Applicants invite the Examiner to telephone the undersigned attorney of record if the Examiner feels that the call will be beneficial to advance prosecution of the application.

Respectfully submitted,

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